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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,984	08/21/2001	Kazuhisa Fushihara	0020-4891P-SP	6825

2292 7590 01/29/2004

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EXAMINER

GORDON, RAEANN

ART UNIT PAPER NUMBER

3711

DATE MAILED: 01/29/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/932,984

Applicant(s)

FUSHIHARA, KAZUHISA

Examiner

Raeann Gorden

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1,2 and 4-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,6-8 and 10-12 is/are rejected.
- 7) ☒ Claim(s) 2,5 and 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not support a golf ball specific gravity less than 0.5.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The range for the specific gravity is broader than the range in base claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 6-8, and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimasa et al (JP 06-327791) in view of Egashira et al (5,439,227). Regarding claims 1 and 12, Yoshimasa discloses a two-piece golf ball comprising a core and a cover. The golf ball has a PGA compression from 70 to 95, which converts to a deformation of 2.54 to 3.32 mm when applying an initial load of 98 N to a final load of 1275 N (see paper #10, page 6). The specific gravity of the ball is greater than or equal to 0.5 but less than 1.0. Yoshimasa discloses the cover has a flex modulus from 1500 –3000 kg/cm² (147 –294 Mpa), which borders applicant's range, but does not disclose a flex modulus for the cover between 300 and 500 Mpa. However, Egashira teaches a cover with a flex modulus from 200 to 450 Mpa. Each cover example cited in Egashira has a flex modulus of 350 Mpa (table 1). Dividing the deformation of 2.54-3.32 mm (D) of Yoshimasa with the flex modulus 350 Mpa (F) of Egashira gives a F/D ratio of 105, which falls within applicant's range 50 to 125. Regarding claim 4, dividing the deformation of 2.54-3.32 mm (D) of Yoshimasa with the flex modulus 350 Mpa (F) of Egashira gives a F/D ratio of 105 (350/3.32), which falls within applicant's range 55 to 120. Regarding claim 6, Egashira teaches a cover with a flex modulus from 200 to 450 Mpa. Each cover example cited in Egashira has a flex modulus of 350 Mpa (table 1). Regarding claim 7, The golf ball has a PGA compression from 70 to 95, which converts to a deformation of 2.54 to 3.32 mm when applying an initial load of 98 N to a final load of 1275 N (see paper #10, page 6). Regarding claim 8,

dividing the deformation of 2.54-3.32 mm (D) of Yoshimasa with the flex modulus 350 Mpa (F) of Egashira gives a F/D ratio of 105 (350/3.32), which falls within applicant's range 65 to 110. Regarding claims 10 and 11, Yoshimasa discloses the specific gravity of the ball is greater than or equal to 0.5 but less than 1.0. One of ordinary skill in the art would have modified Yoshimasa with Egashira to increase the durability and provide a pleasant feel on impact for the golf ball (see Egashira col. 5, line 35).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09/854,693. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present invention and the '693 application claim golf balls with overlapping property values. The '693 application claims a golf ball comprising a core and a cover. The deformation is from 3.0 to 6.0 mm

and the flex modulus is from 80 to 300 MPa. The present invention claims a deformation from 3.1 to 5.0 mm and a flex modulus from 200 to 600 MPa. It would be obvious to one skilled in the art to vary the flex modulus and deformation to achieve the desired hardness of the golf ball.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant is advised that should claim 1 be found allowable, claim 12 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Allowable Subject Matter

Claims 2, 5, and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments, see pages 10-11, filed 11-5-03, with respect to the Yamagishi reference have been fully considered and are persuasive. The rejection of claim 2 has been withdrawn.

Applicant's arguments filed 10-11-03 with respect to claims 1 and 4 have been fully considered but they are not persuasive. Applicant argues the distinctions between the present invention and the primary reference, Yoshimasa. Applicant states Yoshimasa fails to disclose a flex modulus for the cover between 300 and 500 MPa. The Examiner agrees. The secondary reference, Egashira, is added to teach the limitations not disclosed by Yoshimasa. Applicant further argues the present invention has significant differences from the secondary reference, Egashira. However, the reference is only used to teach a golf ball cover having a flex modulus from 200-450 Mpa. While Egashira does teach about the disadvantages of certain two-piece golf balls the entire disclosure can not be ignored. As previously stated, Egashira is cited to teach the material of the cover layer only. Egashira clearly states a golf ball including a cover layer with a flex modulus from 200 to 450 MPa results in increased durability and a pleasant feel on impact (col. 5). Not only does Egashira include applicant's range, but each example has a flex modulus of 350 MPa, which falls within applicant's claimed range from 300 to 500 MPa.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the primary

reference discloses each limitation claimed by applicant except the flex modulus of the cover. However, the range borders the range claimed by applicant. One of ordinary skill in the art would be lead to modify the cover of Yoshimasa with Egashira because Egashira teaches a cover layer that provides increased durability and a pleasant feel on impact.

A new double patenting warning has been included over newly added claim 12. The Examiner fails to see a distinction between "a two-piece golf ball comprising a core and cover" and "a two-piece golf ball consisting of a core and cover". Since the "two-piece" language inherently limits the golf ball to two pieces there appears to be no difference between the claims.

Since applicant does not advance arguments regarding the double patenting rejection it is maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raeann Gorden whose telephone number is 703-308-8354. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



Raeann Gorden
Examiner
Art Unit 3711

Rg
January 24, 2004